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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: §  
Stanley Mo et al. § Art Unit: 3627  
§  
Serial No.: 09/540,968 §  
§ Examiner: Andrew J. Rudy  
Filed: March 31, 2000 §  
§  
For: Managing On-Line § Atty Docket: ITL.0365US  
Transactions § (P8584)  
§  
Customer No.: 21906 § Assignee: Intel Corporation

**Mail Stop Appeal Brief-Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

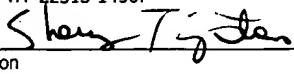
## RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Dear Sir:

On April 19, 2005, the undersigned and examiner Andrew Rudy discussed the Notification of Non-Compliant Appeal Brief, mailed on March 22, 2005. An amended Appeal Brief is being submitted along with this response.

Date of Deposit: April 22, 2005

I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Sherry Tipton

## **REMARKS**

In a telephone conversation on April 19, 2005, examiner Rudy and the undersigned agreed that a grouping of claims was not required and that the statement listing the grounds of rejection was adequate. *See* 69 Fed. Reg. 49960, 49962 (2004), attached. As such, the only remaining issue of non-compliance was related to the Summary of Claimed Subject Matter section of the brief. The Summary section was amended to be in compliance with Rule 41.37. *Id.* at 49976, 49979, 50006.

Although not specifically discussed, the Appeal Brief filed on December 27, 2004, was indicated in the Notice as being defective for failing to contain the items required under 37 C.F.R. § 41.37(c), or the items are not under the proper heading or in the proper order. But, the Appeal Brief filed on December 27, 2004 included all of the items required under 37 C.F.R. § 41.37(c). In particular, the brief followed the example format and content for an appeal brief provided by the Department of Commerce, Patent Control Office. *See* 69 Fed. Reg. 49960, 49978-49979 (2004) attached. Thus, every part or item required by 37 C.F.R. § 41.37(c) was included in the Appeal Brief submitted on December 27, 2004, and is in the brief submitted herewith.

## **CONCLUSION**

An amended Appeal Brief is being submitted herewith. The amended brief is believed to be in compliance with new Rule 41.37(c). In particular, the statement of the Grounds of Rejection for Review on Appeal page follows the example given in the Federal Register. Accordingly, this section is believed to be in compliance with Rule 41.37(c)(vi). Also, the claims have not been grouped as was required by Rule 192(c)(7), now removed and reserved. *See* 69 Fed. Reg. 49960, 49962 (2004), attached. Thus, the brief has been amended to correct for the lack of reference to character references in the Summary of Claimed Subject Matter section. Accordingly, the amended Appeal Brief is now in compliance with Rule 41.37(c).

Respectfully submitted,

Date: April 22, 2005



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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

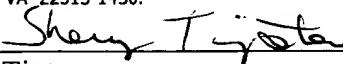
In re	Stanley Mo et al.	§	Art Unit:	3627
Applicant:		§	Examiner:	Andrew J. Rudy
Serial No.:	09/540,968	§	Docket No.:	ITL.0365US(P8584)
Filed:	March 31, 2000	§	Assignee:	Intel Corporation
Title:	Managing On-Line Transactions	§	Confirmation No.:	2086
Customer No.:	21906	§		

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

## AMENDED APPEAL BRIEF

Date of Deposit: April 22, 2005

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Sherry Tipton



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## **REAL PARTY IN INTEREST**

The real party in interest is the assignee Intel Corporation.

## **RELATED APPEALS AND INTERFERENCES**

None.

## **STATUS OF CLAIMS**

Claims 1-30 have been twice rejected and are the subject of this appeal.

## **STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the rejection dated September 16, 2004.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

To explain some embodiments of the present invention, character reference numbers for the Figures in the subject application have been included as parenthetical information in the summaries below. The inclusion of the reference numbers is for explanatory purposes only.

### ***Independent Claims 1 and 10:***

The method of claim 1 recites receiving an electronic indication of an inventory allocation, completing a plurality of on-line sales transactions against said allocation, and in response to the depletion of said allocation, automatically requesting an additional inventory allocation. Claim 10 is an article claim that corresponds to claim 1.

In some embodiments of the present invention, an on-line transaction service (12) may receive an electronic indication of an inventory allocation from a product vendor inventory management system (16), for example over a network (14). Specification, page 4, line 23-page 5, line 11; page 6, lines 1-4 and 10-13; page 7, lines 3-12. *See also* Figure 1 at 12, 13, 20, 14, 16, 17, and 52; Figure 2 at 20, 22, 24, 26, 28 and 30. The on-line transaction service (12) may complete a plurality of on-line sales transactions (14 and 18) against the inventory allocation. Specification, page 4, lines 8-22; page 8, line 19-page 9, line 3. *See also* Figure 1 at 12, 13, 20, 14, and 18; Figure 4 at 40, 42, 44, 46, 48, and 50. In response to the depletion of the inventory allocation, the on-line transaction service (12) may automatically request an additional inventory allocation from the product vendor inventory management system (16), for example over the

network (14). Specification, page 5, line 12-page 8, line 18. *See also* Figure 1 at 12, 13, 14, 16, and 20; Figures 2 and 3 at 20, 22, 24, 26, 28, 32, 34, 36, and 38.

***Independent Claim 19:***

Claim 19 calls for a server that completes a plurality of on-line sales transactions against an electronic indication of an inventory allocation, a memory coupled to the server that stores the inventory allocation, and the server decrements the inventory allocation with each on-line sales transaction, monitors the inventory allocation and automatically requests an additional inventory allocation.

In some embodiments of the present invention, an on-line transaction service may include a server (12) that completes a plurality of on-line sales transactions (14 and 18) against an electronic indication of an inventory allocation. Specification, page 4, lines 8-22; page 8, line 19-page 9, line 8. *See also* Figure 1 at 12, 13, 20, 14, and 18; Figure 4 at 40, 42, 44, 46, 48, and 50. A memory (13) may be coupled to the server (12) that stores the inventory allocation. Specification, page 4, line 26-page 5, line 23; page 6, lines 1-13. *See also* Figure 1 at 12, 13, and 20; Figure 2 at 20, 22, 24, 26, 28 and 30. The server (12) for the on-line transaction service decrements the inventory allocation with each on-line sales transaction, monitors the inventory allocation, and automatically requests an additional inventory allocation. Specification, page 4, lines 16-page 8, line 18. *See also* Figure 1 at 12, 13, 14, 16, 18, and 20; Figures 2 and 3 at 20, 22, 24, 26, 32, 34, 36, and 38.

***Independent Claims 23 and 26:***

The method of independent claim 23 calls for providing an electronic allocation of an inventory allocation to an on-line sales transaction service, receiving a request from said on-line sales transaction service for an additional inventory allocation, and providing said on-line sales transaction service with an additional inventory allocation. Independent claim 26 is an article claim that generally corresponds to claim 23.

In some embodiments of the present invention, a product vendor inventory management system (16) provides an electronic allocation of an inventory allocation to an on-line sales transaction service (12), for example over a network (14). Specification, page 4, line 26-page 5, line 23; page 9, lines 9-23. *See also* Figure 1 at 12, 14, 16, 17, and 52; Figure 5 at 60. The product vendor inventory management system (16) may receive a request from the on-line sales transaction service (12) for an additional inventory allocation, again over the network (14). Specification, page 4, line 26-page 5, line 23; page 9, lines 4-8. *See also* Figure 1 at 12, 14, 16, 17, and 52; Figure 5 at 54 and 56. The product vendor inventory management system (16) may provide the on-line sales transaction service (12) with an additional inventory allocation *e.g.*, over the network (14). Specification, page 5, lines 12-23; page 9, lines 9-23. *See also* Figure 1 at 12, 14, 16, 17, and 52; Figure 5 at 60.

***Independent Claim 29:***

Claim 29 calls for a server, and a storage storing software that causes the server to provide an electronic indication of an inventory allocation to an on-line sales transaction service, receive a request from the on-line sales transaction service for an additional

inventory allocation, and provide an additional inventory allocation to the on-line sales transaction service.

In some embodiments of the present invention, a product vendor inventory management system includes a server (16) and storage (17) storing software (52). Specification page 5, lines 20-23; page 9, lines 4-8; Figure 1 at 16, 17, and 52. The server (16) for the product vendor inventory management system provides an electronic indication of an inventory allocation to an on-line sales transaction service (12), for example over a network (14). Specification, page 4, line 26-page 5, line 23; page 9, lines 9-23; Figure 1 at 12, 14, 16, 17, and 52; Figure 5 at 60. The server (16) receives a request from the on-line sales transaction service (12), for example over the network (14), for an additional inventory allocation. Specification, page 4, line 26-page 5, line 23; page 9, lines 4-8. *See also* Figure 1 at 12, 14, 16, 17, and 52; Figure 5 at 54 and 56. The server (16) also provides an additional inventory allocation to the on-line sales transaction service (12), again over the network (14) as an example. Specification, page 5, lines 12-19; page 9, lines 9-23. *See also* Figure 1 at 12, 14, 16, 17, and 52; Figure 5 at 60.

At this point, no issue has been raised that would suggest that the words in the claims have any meaning other than their ordinary meanings. Nothing in this section should be taken as an indication that any claim term has a meaning other than its ordinary meaning.

## **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The ground of rejection asserted in the Office action dated, September 16, 2004, is as follows:

1. Claims 1-30 were rejected under 35 U.S.C. §102(a) as being anticipated by Rosenberg (US 6,418,416).

# ARGUMENT

## 1. *Alleged Anticipation of Claims 1-30.*

### A. *Claims 1-18.*

Rosenberg does not anticipate because Rosenberg fails to disclose all of the elements of independent claims 1 and 10, arranged as required by the claims. To anticipate, each and every element of the claimed invention, arranged as required by the claims, must be found in a single prior art reference. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Centrury Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Claim 1 calls for receiving an electronic indication of an inventory allocation, completing a plurality of on-line sales transactions against the allocation, and in response to the depletion of the allocation, automatically requesting an additional inventory allocation. Rosenberg fails to disclose an on-line sales transaction service that completes a plurality of on-line sales transactions against an inventory allocation.

Neither Rosenberg's customer site 105 nor his portal site 152 complete a plurality of on-line sales transactions against an inventory allocation, and in response to the depletion of the allocation, automatically request an additional inventory allocation. For example, the examiner cites to element 268 of Rosenberg as an electronic inventory. *See* Office action dated July 27, 2004. Item 268 is an option that allows an authorized user

(i.e. user 160) to view cabinet inventory via a portal site's web server 152. *See column 5, line 49; column 6, lines 32-51; Figure 1.* However, there is no teaching or suggestion in Rosenberg that the customer site sells the cabinet inventory on-line. Thus, the customer site does not complete on-line sales transactions against an inventory allocation.

Also, the portal 152 does not complete on-line sales transactions against an inventory allocation. For example, vendors 220 deliver supplies directly to the customer site. *See column 2, lines 8-16; column 6, lines 20-29; Figure 3.* Thus, the portal site does not have an inventory allocation to complete a plurality of on-line sales against.

Taken together, neither the customer site 105 nor the portal site 152 in Rosenberg complete a plurality of on-line sales transactions against an allocation of inventory. Accordingly, Rosenberg does not anticipate independent claims 1 and 10.

#### *B. Claims 19-22.*

Rosenberg does not anticipate independent claim 19 because all of the limitations are not disclosed.

For example, claim 19 calls for a server that completes a plurality of on-line sales transactions against an electronic indication of an inventory allocation, a memory coupled to said server that stores said inventory allocation, and said server decrements said inventory allocation with each on-line sales transaction, monitors the inventory allocation and automatically requests an additional inventory allocation. Rosenberg fails to

specifically disclose a server that completes a plurality of on-line sales transactions against an electronic indication of an inventory allocation.

As explained above in section A, neither the customer site nor the portal site in Rosenberg complete on-line sales transactions. Additionally, the web server at Rosenberg's portal site does not complete on-line transactions against an inventory allocation. For example, the server may be accessed by an authorized user (160) to view the contents in a cabinet. *See* Figure 1; column 6, lines 32-51. However, there is no indication that the server is used to complete a plurality of on-line sales transactions against the contents in the cabinet. Thus, for this additional reason, Rosenberg does not anticipate claim 19.

### *C. Claims 23-28.*

Rosenberg fails to anticipate independent claims 23 and 26 because each limitation of the claims is not disclosed.

For example, claim 23 calls for providing an electronic allocation of an inventory allocation to an on-line sales transaction service, receiving a request from said on-line sales transaction service for an additional inventory allocation, and providing said on-line sales transaction service with an additional inventory allocation.

As previously mentioned, the examiner cites to element 268 of Rosenberg as an electronic inventory. *See* Office action dated July 27, 2004. However, item 268 merely allows an authorized user (i.e. user 160) to view cabinet inventory via a web site. *See* column 5, line 49; column 6, lines 32-51. Thus, there is no express or implied teaching in

Rosenberg that the inventory in the cabinets is sold on-line. Clearly, the customer site is not an on-line sales transaction service.

Similarly, there is no indication that the supplier interface 165 in Rosenberg provides an electronic allocation of inventory to an on-line sales transaction service. That is, the customer site is not an on-line sales transaction service. Also, there is no indication that Rosenberg's supplier interface provides the portal site with inventory information. That is, inventory information at the portal site is gathered from the customer site. For example, vendors 220 deliver inventory to the customer site to stock the cabinets. Column 2, lines 13-16; column 4, lines 10-20; column 6, lines 20-25. A controller associated with a cabinet collects inventory data. Column 4, lines 10-31. In one example, pressure sensitive switches are actuated when the cabinets are stocked or items removed. *Id.* The cabinet controller communicates with the portal's server, and the server tracks cabinet activity and analyzes cabinet inventory levels. Column 4, lines 36-41; column 5, lines 11-14. Thus, the portal site obtains cabinet inventory information from the customer site.

There is no express or implied teaching in Rosenberg that the portal site receives inventory information from vendors. That is, authorized users (160) may access the supplier to track purchase orders and order histories and receive account information and invoices (through supplier interface 165). However, Rosenberg fails to disclose that this information is transmitted from the supplier interface 165 to the portal 152. *See* column 6, lines 1-5. As such, neither the portal site nor the supplier interface provides an

electronic indication of an inventory allocation or an additional inventory allocation to an on-line sales transaction service.

Because every limitation of claims 23 and 26 are not taught or suggested, Rosenberg does not anticipate either claim.

*D. Claims 29 and 30.*

Rosenberg does not anticipate claim 29. Again, Rosenberg fails to teach all of the limitations of the claim.

Independent claim 29 calls for a server, and a storage storing software that causes the server to provide an electronic indication of an inventory allocation to an on-line sales transaction service, receive a request from the on-line sales transaction service for an additional inventory allocation, and provide an addition inventory allocation to an on-line sales transaction service. Rosenberg fails to disclose a server as claimed in claim 29.

As explained above, the customer site 105 does not sell the supplies on-line. Thus, the servers 130 and 140 at Rosenberg's portal do not provide an electronic indication of an inventory allocation to an on-line sales transaction service.

Also, as explained above, the vendor does not provide the portal site with inventory information through the interface 165. In some instances the supplier interface may be a server. Column 5, line 6. Even so, there is no specific teaching in Rosenberg that inventory information is sent from the supplier server to the portal site. Thus, the supplier server too does not provide an electronic indication of an inventory allocation or an additional allocation of inventory to an on-line sales transaction service.

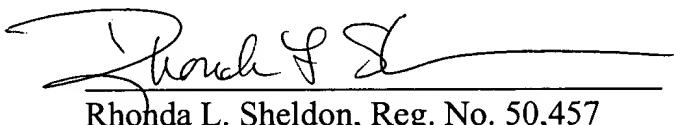
Because all limitations of claim 29 are not taught or suggested by Rosenberg, *prima facie* anticipation has not been established.

## CONCLUSION

As discussed above in the arguments section of this appeal brief Rosenberg fails to disclose every limitation of the independent claims. Thus, *prima facie* anticipation has not been established; reversal of the rejections and allowance of the application is requested.

Respectfully submitted,

Date: April 22, 2005



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## CLAIMS APPENDIX

1. A method comprising:
  - receiving an electronic indication of an inventory allocation;
  - completing a plurality of on-line sales transactions against said allocation;and
  - in response to the depletion of said allocation, automatically requesting an additional inventory allocation.
2. The method of claim 1 further including maintaining a count of available inventory allocation and decrementing said count as each on-line transaction is completed.
3. The method of claim 1 wherein receiving an electronic indication of an inventory allocation includes receiving said inventory allocation from a remote site.
4. The method of claim 1 wherein receiving an electronic indication of an inventory allocation includes receiving said allocation over a network.
5. The method of claim 4 wherein receiving an electronic indication of an inventory allocation includes receiving said allocation over the Internet.
6. The method of claim 1 wherein requesting an additional inventory allocation includes determining whether the inventory allocation needs to be replenished.
7. The method of claim 6 wherein determining whether the inventory allocation needs to be replenished includes determining whether an inventory allocation has been reduced through the completion of on-line transactions below a preset level.

8. The method of claim 6 wherein determining whether the inventory allocation needs to be replenished includes determining the rate at which on-line transactions are being completed and implementing a dynamic calculation that considers the rate at which on-line transactions are being completed.

9. The method of claim 8 including utilizing the rate at which transactions are completed and the rate at which additional inventory is to be requested to determine whether the inventory allocation needs to be replenished.

10. An article comprising a medium for storing instructions that enable a computer to:

receive an electronic indication of an inventory allocation;  
complete a plurality of on-line sales transactions against said allocation;

and

in response to the depletion of said allocation, automatically request an additional inventory allocation.

11. The article of claim 10 further storing instructions that enable a computer to maintain a count of available inventory allocation and decrement said count as each on-line transaction occurs.

12. The article of claim 10 further storing instructions that enable a computer to receive an inventory allocation from a remote site.

13. The article of claim 10 further storing instructions that enable a computer to receive said allocation over a network.

14. The article of claim 13 further storing instructions that enable a computer to receive said allocation over the Internet.

15. The article of claim 10 further storing instructions that enable a computer to determine whether to request an additional inventory allocation based on the number of on-line sales transactions completed against said allocation.

16. The article of claim 15 further storing instructions that enable a computer to determine whether the inventory allocation has been reduced below a preset level.

17. The article of claim 15 further storing instructions that enable a computer to implement a dynamic calculation that considers the rate at which on-line transactions are being completed.

18. The article of claim 17 further storing instructions that enable a computer to utilize the rate at which transactions are completed and the rate at which additional inventory is to be requested to determine whether the inventory allocation needs to be replenished.

19. A system comprising:

a server that completes a plurality of on-line sales transactions against an electronic indication of an inventory allocation;

a memory coupled to said server that stores said inventory allocation; and said server decrements said inventory allocation with each on-line sales transaction, monitors the inventory allocation and automatically requests an additional inventory allocation.

20. The system of claim 19 wherein said server is coupled to the Internet and completes transactions over the Internet.

21. The system of claim 19 wherein said server dynamically determines when to request an additional inventory allocation based at least in part on the rate at which transactions are being completed.

22. The system of claim 21 wherein said server requests an additional inventory allocation based at least in part on a predetermined frequency for requests for an additional inventory allocation.

23. A method comprising:

providing an electronic allocation of an inventory allocation to an on-line sales transaction service;

receiving a request from said on-line sales transaction service for an additional inventory allocation; and

providing said on-line sales transaction service with an additional inventory allocation.

24. A method of claim 23 further including providing a frequency for requests for additional allocation.

25. A method of claim 23 including providing the indication of an inventory allocation over the Internet.

26. An article comprising a medium that stores instructions that enable a computer to:

provide an electronic indication of an inventory allocation to an on-line sales transaction service;

receive a request from said on-line sales transaction service for an additional inventory allocation; and

provide said on-line sales transaction service with an additional inventory allocation in response to said request.

27. The article of claim 26 further storing instructions that enable a computer to provide a frequency for requests for an additional inventory allocation.

28. The article of claim 26 further storing instructions that enable a computer to provide said inventory allocation over the Internet.

29. A system comprising:

a server; and

a storage storing software that causes said server to provide an electronic indication of an inventory allocation to an on-line sales transaction service, receive a request from said on-line sales transaction service for an additional inventory allocation, and provide an additional inventory allocation to said on-line sales transaction service.

30. The system of claim 29 wherein said server is coupled to the Internet.

## **EVIDENCE APPENDIX**

None.

## **RELATED PROCEEDINGS APPENDIX**

None.



# Federal Request

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Thursday,  
August 12, 2004



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## Part II

## Department of Commerce

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Patent and Control Office

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**37 CFR Parts 1, 5, 10, 11, and 41**  
**Rules of Practice Before the Board of**  
**Patent Appeals and Interferences; Final**  
**Rule**

**DEPARTMENT OF COMMERCE****Patent and Trademark Office****37 CFR Parts 1, 5, 10, 11, and 41****RIN 0651-AB32****Rules of Practice Before the Board of Patent Appeals and Interferences****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

**SUMMARY:** The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office consolidates and simplifies the rules governing practice before the Board of Patent Appeals and Interferences to reflect developments in case law, legislation, and administrative practice.

**DATES:** Effective date: September 13, 2004.

**FOR FURTHER INFORMATION CONTACT:**  
*Appeals:* Jeffrey V. Nase or William F. Smith, 703-308-9797.

*Otherwise:* Richard Torczon, 703-308-9797.

**SUPPLEMENTARY INFORMATION:****Background**

The Board of Patent Appeals and Interferences (Board) has significantly overhauled its operations to address concerns about the duration of proceedings before the Board. This final rule reflects these new procedures. A notice of proposed rule making on this topic was published in the **Federal Register** (68 FR 66648, Nov. 26, 2003) and in the **Official Gazette** of the United States Patent and Trademark Office (1277 OG 139, Dec. 23, 2003). Seventeen comments have been received in response to that notice.

**Explanation of changes**

In keeping with long-standing patent practice, rules in title 37, part 1, of the Code of Federal Regulations are denominated "Rule x" in this supplementary information.

Rules 1(a)(1)(iii), 5(e), and 8(a)(2)(i)(B), and subpart E of part 1, are removed to consolidate interference information in part 41, subparts D and E.

Rules 1(a)(1)(ii); 4(a)(2); 6(d)(9); 8(a)(2)(i)(C); 9(g); 11(e); 17(b); 36; 59(a)(1); 103(g); 112; 113(a); 114(d); 131(a)(1); 136(a)(1) and (a)(2); 181(a)(3); 191; 248(c); 292(a) and (c); 295(b); 302(b); 303(c); 304(a)(1) and (a)(2); 322(a)(3); 323; 324; 565(e); 701(c)(2)(ii); 703(a)(4), (b)(3)(ii), (b)(4), (d)(2), and (e); 704(c)(9); 959; and 993 are revised to

change cross-references to Board proceedings.

Rules 17(b)–(d) and (h) are revised to remove the Board fees, which will be relocated to § 41.20.

Rules 48(a)–(c) and (i) are revised, and Rule 48(j) added, to consolidate the cross-reference correction of inventorship for applications in contested cases before the Board.

Rules 55(a)(3) and (a)(4), and 136(b) are revised to eliminate the cross-references to Board rules.

Rule 116 is amended to limit amendments after a final rejection or other final action (Rule 113) in an application or in an ex parte reexamination filed under Rule 510, or after an action closing prosecution (Rule 949) in an inter partes reexamination filed under Rule 913, to such amendments filed before or with any appeal to the Board under § 41.31 or § 41.61. Amendments after appeal currently treated under Rule 116 are moved to §§ 41.33 and 41.63. Pursuant to § 41.33(a), amendments filed after appeal and prior to the filing of the appeal brief will be treated under the same standard as Rule 116. The section title is revised to reflect the scope of the rule more accurately.

Rule 116(d) is amended to permit only an amendment canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, to be made in an inter partes reexamination proceeding after the right of appeal notice has issued under Rule 953, except as provided in Rule 981 or as permitted by § 41.77(b)(1).

Rule 116(e) is added to set forth a standard for treatment of an affidavit or other evidence submitted after a final rejection or other final action (Rule 113) in an application or in an ex parte reexamination filed under Rule 510, or in an action closing prosecution (Rule 949) in an inter partes reexamination filed under Rule 913, but before or with any appeal (§ 41.31 or § 41.61). The standard would be that such an affidavit or other evidence could be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. This standard is currently in effect under Rule 195 for an affidavit or other evidence submitted after appeal.

Rule 116(f) is added to prohibit affidavits and other evidence in an inter partes reexamination proceeding after the right of appeal notice under Rule 953, except as provided in Rule 981 or as permitted by § 41.77(b)(1).

Rule 191 is amended to direct appellants under 35 U.S.C. 134(a) or (b) to part 41.

Rules 192–196 are removed and reserved.

Rule 197 is amended by changing its title to "Return of jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings" to reflect the two remaining paragraphs of this section. The subject matter of paragraph (b) is moved to § 41.52 and the subject matter of paragraph (c) is moved to paragraph (b) of Rule 197. Paragraph (a) is amended to return of jurisdiction of the involved application or patent under ex parte reexamination proceeding to the examiner. Rule 41(d)(2), Fed. R. App. Procedure, controls when the mandate of the Court of Appeals will issue in the event that a party filed a petition for writ of certiorari to the United States Supreme Court. Unless a party petitioning for a writ of certiorari seeks and obtains a stay of the appellate court's mandate, proceedings will be considered terminated with the issuance of the mandate, as noted in Rule 197(b)(2).

Rule 198 is amended by changing its title to "Reopening after a final decision of the Board of Patent Appeals and Interferences" to reflect the substance of the section and to clarify that it applies when a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review.

Rule 324(a) and (c) are revised, and Rule 324(d) added, to consolidate cross-references to correction of inventorship for patents in contested cases before the Board.

Rule 959 is revised to direct inter partes reexamination participants to part 41 for information about appeals in such proceedings.

Rules 961–977 are removed to consolidate inter partes reexamination appeal information in part 41.

Rule 979 is amended by changing its title to "Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings" to reflect the two paragraphs of this section. Most of the subject matter of current paragraphs (a)–(g) is moved to §§ 41.79, 41.81 and 41.83. Paragraph (a) is amended to recite that jurisdiction over an inter partes reexamination proceeding passes to the examiner after a decision by the Board of Patent Appeals and Interferences upon transmittal of the file to the examiner, subject to each appellant's right of appeal or other review, for such further action as the condition of the inter partes reexamination proceeding may require, to carry into effect the

application for a patent, an application for reissue of a patent, or an ex parte reexamination proceeding to the Board.

Section 41.30 sets forth definitions for Board proceedings under subpart B of part 41. The preamble to § 41.30 is based on a similar provision in the preamble of former Rule 601. The term "proceeding" sets forth a generic term for a national application for a patent, an application for reissue of a patent, and an ex parte reexamination proceeding. The term "applicant" sets forth a generic term for either the applicant in a national application for a patent or the applicant in an application for reissue of a patent. The term "owner" sets forth a shorthand reference to the owner of the patent undergoing ex parte reexamination under Rule 510.

Section 41.31 is added to generally incorporate the requirements of former Rule 191(a)–(d). Paragraph (a) is subdivided into three parts to improve readability. Paragraph (d) is amended to refer only to the time periods referred to in paragraphs (a)(1)–(a)(3) of this section, while the current extension of time requirements for Rules 192, 193, 194, 196 and 197, formerly provided in Rule 191(e), is relocated to §§ 41.37, 41.41, 41.47, 41.50 and 41.52.

Section 41.33 is added to replace the requirements of former Rules 116 and 195. Paragraph (a) provides that amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116. Thus, amendments after final but prior to appeal and amendments filed after appeal but prior to the date the brief is filed will be treated under the same standard (i.e., § 1.116). Paragraph (b) provides that amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted: (1) to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or (2) to rewrite dependent claims into independent form. A dependent claim is rewritten into independent form by including all of the limitations of the base claim and any intervening claims. Thus, no limitation of a dependent claim can be excluded in rewriting that claim into independent form. Paragraph (c) provides that all other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c). Paragraph (d)(1) provides that affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) and prior to the date

of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavits or other evidence overcomes all rejections under appeal and that there is a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Paragraph (d)(2) provides that all other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). Paragraph (d) replaces the former practice of permitting such evidence based on a showing of good and sufficient reasons why such evidence was not earlier presented set forth in former Rule 195. The Office believes that prosecution should occur before the examiner prior to an appeal being filed, not after the case has been appealed pursuant to § 41.31(a)(1)–(a)(3).

Section 41.35 is added to generally incorporate the requirements of former Rule 191(e). In addition, this section makes clear that jurisdiction over an application may be relinquished by the Board and the application returned to the examining operation to permit processing to be completed by the examining operation before the Board takes up the appeal for decision. This is consistent with the present practice of returning an appealed application to the examining operation where some matter requiring attention has been identified prior to assignment of the appeal number and docketing of the appeal. In addition, the Board is permitted to take other appropriate action to complete the file.

Section 41.37 is added to generally incorporate the requirements of former Rule 192. In addition, the following changes have been made:

(1) The title of the section has been changed from "Appellant's brief" to "Appeal brief".

(2) In paragraph (a), one copy of the brief is required rather than three copies consistent with the Office's move to an electronic file wrapper.

(3) In paragraph (a), the brief is required to be filed within two months from the date of the notice of appeal under § 41.31 even if the time allowed for reply to the action from which the appeal was taken is later, which overall simplifies docketing of the due date.

(4) In paragraph (c)(1)(i), a statement is required in the brief identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest. This provides appellant the necessary mechanism for complying with § 41.8(a) in an appeal to the Board.

(5) In paragraph (c)(1)(ii), identification is required of all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, as well as to set forth a mechanism for complying with § 41.8(b) in an appeal to the Board.

(6) In paragraph (c)(1)(iii), both a statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed is required.

(7) In paragraph (c)(1)(v), a concise explanation of the invention is required for each of the independent claims involved in the appeal, which explanation shall refer to the specification by page and line number, and to the drawings, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The former requirement of Rule 192(c)(5) to set forth a concise explanation of the invention defined in the claims involved in the appeal by reference to the specification by page and line number, and to the drawings, if any, by reference characters was not being followed in a great number of briefs before the Board.

(8) In paragraph (c)(1)(vi), a concise statement listing each ground of rejection presented for review is required rather than issues for review. An example of a concise statement is "Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X."

(9) The grouping of claims requirement set forth in former Rule 192(c)(7) is removed. The general purpose served by former Rule 192(c)(7) is addressed in § 41.37(c)(1)(viii). The existing grouping of claims requirement has led to many problems such as (i) Grouping of claims across multiple rejections (e.g., claims 1–9 rejected under 35 U.S.C. 102 over A while claims 10–15 are rejected under 35 U.S.C. 103 over A and the appellant

to identify related proceedings is ambiguous with respect to its scope. The comment believes that read broadly, it would require an appellant to identify every precedential decision that might bear on the issues on appeal and could expose an appellant to unreasonable allegations of inequitable conduct.

**Answer:** The requirement in § 41.37(c)(1)(ii) to identify related proceedings does not require an appellant to identify prior proceedings involving unrelated parties including precedential decisions that might bear on the issues on appeal. The requirement in § 41.37(c)(1)(ii) to identify related proceedings does require an appellant to identify every related proceeding (e.g., commonly owned applications having common subject matter, claim to a common priority application).

**Comment 52:** One comment suggests that § 41.37(c)(1)(iii) be deleted in its entirety, as it introduces an unnecessary additional burden on appellants with no discernible benefit to the Office. The comment states that since only rejected claims are subject to an appeal, there seems to be no benefit in identifying the status of claims that are not subject to appeal and that asking appellants to make this type of listing for claims that are not rejected and thus are not subject to appeal, would introduce a risk of inadvertent error by appellants and in any event, would likely be ignored by the examiner and the Board.

**Answer:** The suggestion will not be adopted. Section 41.37(c)(1)(iii) generally incorporates only the requirements of former § 1.192(c)(3) (2003) that a statement of the status of all the claims be presented and an identification of those claims that are being appealed. As such it does not introduce an unnecessary additional burden on appellants. Moreover, the benefit to the Office of this requirement is that the Board is directly informed as to the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and which of those claims that are being appealed. For example, should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, the Board under the authority of § 41.50(b) may make a new ground of rejection.

**Comment 53:** One comment expresses concern in regard to the requirement of proposed § 41.37(c)(1)(v) that a concise explanation of the subject matter defined in each of the independent claims involved in the appeal be provided. Specifically the comment asks what is a concise statement, what is

required, does the explanation have to show how each claim is different, does the requirement apply to all drawings and embodiments, or only a representative drawing? The comment states that the Office deleted a similar requirement in 1992 relating to documents submitted in an IDS because "concise explanation" descriptions rarely communicated any useful information, improved the quality of patent examination but provided an opportunity to attack the patent on the grounds of inequitable conduct. The comment suggests that the requirement be clarified or dropped.

**Answer:** A patentability determination must be performed on a claim-by-claim basis. The first step in a patentability determination is to construe a given claim and determine its metes and bounds. "Analysis begins with a key legal question—what is the invention claimed?" since "[c]laim interpretation \* \* \* will normally control the remainder of the decisional process."

*Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). The existing provisions of 37 CFR § 1.192(c)(5) (2003) are directed to providing a summary of the "invention," not the claims. See *In re Hiniker Co.*, 47 USPQ2d 1523 (Fed. Cir. 1998): "The invention disclosed in Hiniker's written description may be outstanding in its field, but the name of the game is the claim. See *Giles Sutherland Rich, Extent of Protection and Interpretation of Claims—American Perspectives*, 21 Int'l Rev. Indus. Prop." By statute, the Board reviews "adverse decisions of examiners upon applications for patents." 35 U.S.C. 6(b). For the Board to reach an informed decision on the merits of a rejection presented for review, the record should reflect the respective positions of the examiner and appellant as to the scope of the claims. It is the experience of the Board that the prosecution and examination in a significant number of appeals forwarded for decision on appeal has taken place in the context of "applicant's invention," not on a claim-by-claim basis. Thus, the Board is oftentimes confronted with a record in which no significant claim construction has occurred. Those records are not susceptible to meaningful review and result in an inordinate number of remands.

The determination of how "concise" the explanation must be will need to be determined on a case-by-case basis. If the prosecution and examination has been based upon a discussion of the patentability of individual claims

instead of the "invention," it is expected the explanation will be more "concise" than if the prosecution and examination has been conducted on the basis of the "invention." As to what is required, the proposed rule states that reference to the specification by page and line number, and to the drawing, if any, by reference characters is required. Appellant may include any other information of record which will aid the Board in considering the subject matter of each independent claim. The explanation does not have to show how each claim is different. The purpose of the requirement is to aid the Board in considering the subject matter of the independent claims so that an informed review of the examiner's adverse determination of patentability can be made. Whether the explanation is limited to a single drawing or embodiment or is extended to all drawings and embodiments is a decision appellant will need to make.

The proposed concise explanation of the subject matter defined in each independent claim is different from a concise explanation of a reference. It is the applicant who is responsible for drafting claims and choosing the language and terms used to define the claimed invention. 35 U.S.C. 112(2) ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.") As the originator of the claim language, applicant should know what is intended by the various words and phrases used to define the claimed subject matter and thus, providing a concise explanation of the subject matter of each independent claim as proposed should not be an undue burden. This is in contrast to explaining the possible relevance of a document that may not have originated from applicant. Another difference is that the number of independent claims presented for review in an appeal is a matter directly within appellant's control, while appellant does not have control over the number of documents that should be cited to the Office.

The subject matter of each independent claim needs to be concisely explained for a number of reasons. For example, if the Board decides that a rejection is to be reversed for a given independent claim, the remaining independent claims must be reviewed to determine if the reasons for reversing the rejection of the first independent claim apply to the remaining independent claims. Furthermore, if appellant chooses to argue a group of claims which includes more than one independent claim, the

Board will need to review, at the least, each independent claim to determine which claim will be selected as representative of the group. Apart from reviewing the examiner's adverse decision on patentability, the Board may also make new grounds of rejection pursuant to former § 1.196(b) (2003) or make an explicit statement that a claim would be allowable if amended under former § 1.196(c) (2003). The concise explanation of the subject matter of each independent claim will aid the Board in making these determinations.

**Comment 54:** Several comments address the provision of proposed § 41.37(c)(1)(v) that every means plus function and step plus function as permitted by 35 U.S.C. 112(6) used in the claims be identified and the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. A number of comments express concern that this requirement may result in a limiting claim construction or create prosecution history estoppel. The comments also take the position that the requirement would be unduly burdensome in that appellant would need to provide this analysis whether a claim limitation was in "issue" in the appeal. Another comment indicates that the proposed rule is not clear as to whether it applies to "all drawings and embodiments, or only a representative drawing." Another comment expresses concern that the proposed rule may be subject to abuse, as where an examiner takes the position that claims that are not couched in means-plus-function terminology of 35 U.S.C. 112(6) are nevertheless subject to the provisions of that section and this proposed rule. Suggested changes include using the rule as a procedural tool rather than a substantive requirement or to require only the identification of one or more examples of the support for each independent or separately argued claim, rather than all examples of support for every claim. Another suggested change is that any issues in regard to the Board's need for such an identification in order to reach a reasoned decision be addressed by way of an order under the existing provisions of § 1.196(d) (2003).

**Answer:** The suggestion is adopted to the extent that every means plus function and step plus function as permitted by 35 U.S.C. 112(6) must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number,

and to the drawing, if any, by reference characters only for each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of § 41.37(c)(1)(vii). Whether a statement made by an applicant during procurement of the patent from the Office results in an estoppel is a matter that is ultimately decided during proceedings outside the Office. The decision to grant the patent by the Office must be based upon a firm and clear understanding of the scope of the individual claims. If the prosecution and examination of claims involving issues under 35 U.S.C. 112(6) has been based upon individual claims and in accordance with the procedures set forth in MPEP 2181 for claim language involving issues under this section of the statute, it is anticipated that this aspect of the rule will be based upon the statements and determinations already of record and thus does not constitute a significant burden. See MPEP 2181 (explaining that the Office must apply 35 U.S.C. 112(6) in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application, citing *In re Donaldson*, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)). However, if the prosecution and examination has been based upon the "invention" and not individual claims, it may be that appellant will be making statements regarding claim scope for the first time during the appeal proceeding. To the extent this is seen as a burden or creating a possible estoppel, it may be that this is an indication that the case, while eligible for an appeal under the statute and the rules, may not be ready for an appeal.

The comments expressing concern that the proposed rule extends to 35 U.S.C. 112(6) limitations which are not in "issue" are presumably based upon the perspective that appellant and the examiner have agreed upon the correct construction of such characterized limitations during the prosecution and examination of the application up to the appeal stage, not that such characterized limitations have been ignored or not commented upon during the pre-appeal proceedings. If the former has occurred, it should not be an undue burden to provide the needed analysis. If the latter applies, appellant will need to directly address each limitation so that the record is clear as to where the underlying structure, steps or materials are described in the written description of the application so that the Board can understand the subject matter of the

individual claims presented for review. The suggestion that this provision apply only to the independent claims or claims that are separately argued is adopted.

Issues regarding whether the language chosen by applicant to define a claim limitation falls within 35 U.S.C. 112(6) are discussed in MPEP 2181. Whether specific claim language invokes the provisions of 35 U.S.C. 112(6) is a merits issue to the extent it involves the determination of claim scope. If an applicant believes that an examiner has not followed proper procedure, relief may be had by way of a petition under § 1.181.

The proposal to make this requirement a procedural tool instead of a substantive requirement is not adopted. Claim construction during any stage of a patentability determination is a substantive matter, not a procedural tool, as it controls the substantive application of the law and facts to the claim language under review.

**Comment 55:** A comment was made in regard to proposed § 41.37(c)(1)(vii) that examiners will sometimes only reject the independent claims or make a "jumbled" rejection where it is not clear what arguments apply to which claims. Under these circumstances the comment believes that it is a burden to require appellant to provide separate argument for each and every dependent claim. The comment also states that "it [the rule or the rejection?] pushes Applicants into the position of having to make potentially prejudicial statements regarding claims, where the Examiner has not initially met the burden of providing a *prima facie* case of obviousness. Where the grounds of rejection are of the nature that the Examiner has failed to indicate what grounds of rejection apply to a group of claims, Applicants should simply be able to say this, without thereby risking that the group of claims stands or falls together." A second comment expresses concern that failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately may impact the ultimate presumption of each claim in an issued patent under 35 U.S.C. 282, noting that the current rule does not contain any waiver provision.

**Answer:** Patentability must be decided on a claim-by-claim basis. Merits decisions of the Board in ex parte appeals must determine the patentability of individual claims, not whether an "invention" is patentable or a group of claims is patentable. Thus, the arguments in the Appeal Brief are

preferably directed to individual claims. If appellant chooses to argue claims as a group as permitted, the Board will pick a single claim to decide the appeal to the group of claims as to that ground of rejection. If the prosecution and examination of a case has proceeded to the point of an appeal without applicant and the examiner discussing the merits of individual claims, that is an indication that the case is not ready for an appeal. If applicant believes that a rejection set forth in an Office action is "jumbled" or in any other manner does not clearly communicate the facts and reasons why the individual claims subject to the rejection are unpatentable, relief may be available by way of a petition under § 1.181.

The waiver provision of the proposed rule reflects the view expressed in *In re McDaniel* 63 USPQ2d 1462, 1468 (Fed. Cir. 2002) (Mayer, C.J. dissenting-in-part) that "in stating that claims 53–64 stand or fall together, [McDaniel] has waived any argument that claims 55–57 are patentable for reasons independent of claim 53."

**Comment 56:** One comment notes that each appeal is unique and that there "is no good reason for making detailed requirements as to the form of presentation of explanations and arguments in an appeal brief" as proposed in § 41.37(c)(1)(vii). The comment observes that the "Office properly assumes that an examiner is capable of responding to any appeal brief under either the existing rule or the proposed rule each of which simply requires a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary. The comment asks the questions "Should not the same simple requirements be in effect as to the appeal brief? What's sauce for the goose should be sauce for the gander?"

**Answer:** The structure provided for by the requirements of § 41.37 ensures that Appeal Briefs will provide the information the Board needs to render an informed decision on the issues presented for review. While each appeal is unique in regard to the issues and arguments presented, there is certain information common to each appeal which is amenable to being provided by way of a prescribed format. The view expressed in the comment that examiners are under "simpler requirements in preparing an Examiner's Answer than appellant is in preparing the Appeal Brief" is misplaced. Detailed guidance to examiners as to procedural requirements in performing their duties

and preparing Office actions is typically contained in the MPEP, not the rules. The procedural requirements examiners must follow in preparing an Examiner's Answer are found in MPEP 1208.

**Comment 57:** One comment suggests that § 41.37(c)(1)(vii) be amended to add the word "separate" prior to "patentability" in the last sentence. The comment states that this would clarify that pointing out what a claim recites will not be considered an argument for "separate" patentability of a claim, since such an argument could in fact establish patentability of that claim without establishing "separate" patentability of the claim.

**Answer:** The suggestion to add the word "separate" prior to "patentability" in the last sentence has been adopted in § 41.37(c)(1)(vii) and § 41.67(c)(1)(vii).

**Comment 58:** One comment inquires if the requirement in § 41.37(c)(1)(ix) for an evidence appendix containing copies of any evidence submitted to the examiner and relied upon by the appellant in the appeal was inconsistent with the provision in § 41.7(b) that precludes a party from filing a paper previously filed in the same Board proceeding without Board authorization.

**Answer:** Section 41.7(b) has been amended so that the requirement in § 41.37(c)(1)(ix) for an evidence appendix containing copies of any evidence submitted to the examiner and relied upon by the appellant in the appeal is consistent with the provisions of § 41.7(b).

**Comment 59:** One comment suggests that § 41.37(c)(1)(ix) be amended to require identification of "when the evidence was submitted into the record by Applicants or where in the record that evidence was entered in the record by the Examiner." The comment states that this suggestion was made since examiners will frequently not make a positive statement indicating approval of entry into the record of evidence presented by applicants. The comment states that absent specific indication by the examiner that any evidence submitted was refused entry, the evidence is presumed to have been entered as of the submission date. Thus, the suggested change would remove any ambiguity regarding how to comply with this requirement should the examiner not make an affirmative entry of the evidence.

**Answer:** The suggestion is not adopted. Evidence submitted after final rejection is not presumed to have been entered and must be specifically admitted by the examiner as set forth in § 1.116 as amended by this rule making. Evidence submitted either before the

first Office action or after a non-final rejection may be presumed to have been entered only when treated by an examiner in an Office action.

Accordingly, the requirement of § 41.37(c)(1)(ix) of a statement setting forth where in the record the evidence was entered in the record by the examiner is met by an explicit statement entering the evidence or implicitly by an Office action weighing the evidence. Prior to filing an appeal brief, if applicants have submitted evidence to the examiner and it is not clear if this evidence has been entered or not entered, appellants should contact the examiner to inquire as to the status of that evidence. For example, if a § 1.132 declaration is timely filed in response to non-final Office action and the next action by the examiner is a final rejection which does not mention the § 1.132 declaration, applicants should contact the examiner to inquire as to the status of the § 1.132 declaration before filing an appeal since a brief arguing that evidence is not permitted by § 41.37(c)(1)(ix). The likely result of such an inquiry would be a new Office action treating the § 1.132 declaration or being informed that the Office has no record of the § 1.132 declaration.

**Comment 60:** One comment requests clarification as to whether appendixes as required by §§ 41.37(c)(ix-x) are necessary at all when no evidence or related proceedings exist, or whether an appendix must be included with the indication "none."

**Answer:** Sections 41.37(c)(ix-x) require the appeal to contain an evidence appendix and a related proceedings appendix. If no evidence or related proceedings exist, an evidence appendix should be included with the indication "none" and a related proceedings appendix should be included with the indication "none." In addition, a brief containing a Table of Contents indicating that no evidence appendix is part of the brief or that no related proceedings appendix is part of the brief would be acceptable under the Rule since it would clearly indicate that no evidence is being relied upon by the appellant in the appeal or that no related proceedings having decisions rendered by a court or the Board exist.

**Comment 61:** One comment states that it would be useful to have an example of a format and content for an appeal brief that would comply with the new regulations published with the notice of final rule making and ultimately incorporated into the Manual of Patent Examining Procedure.

**Answer:** An example of a format and content for an appeal brief is a brief

containing the following items, with each item starting on a separate page:

- (1) Identification page setting forth the applicant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Appeal Brief)
- (2) Table of Contents page(s)
- (3) Real party in interest page(s)
- (4) Related appeals and interferences page(s)
- (5) Status of claims page(s)
- (6) Status of amendments page(s)
- (7) Summary of claimed subject matter page(s)
- (8) Grounds of rejection to be reviewed on appeal page(s)
- (9) Argument page(s)
- (10) Claims appendix page(s)
- (11) Evidence appendix page(s)
- (12) Related proceedings appendix page(s).

*Comment 62:* One comment suggests that the reference to §§ 41.31–41.37 in § 41.39(a)(1) be changed to refer to § 41.31 or § 41.37.

*Answer:* The suggestion has been adopted. In addition, a similar change has been made to § 41.69(a)(1).

*Comment 63:* One comment recommends that § 41.39(a)(1) be amended to clarify the manner in which the Director will notify the public as to the time within which the primary examiner will be required to furnish a written answer to the appeal brief.

*Answer:* The comment will not be adopted. The Director currently notifies the public as to the time within which the primary examiner is expected to furnish a written answer to the appeal brief in the MPEP. Section 1208 of the MPEP provides that “[t]he examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner.”

*Comment 64:* Several comments suggest that any new ground of rejection be approved by the appeal conference in the Technology Center or by a Technology Center Director.

*Answer:* The suggestion is adopted to the extent that the MPEP will provide that each examiner's answer containing a new ground of rejection must be approved by a Technology Center Director or designee. An appeal conference is mandatory in all cases in which an acceptable appeal brief has been filed. The participants of the appeal conference should include (1) the examiner charged with the preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as conferee, having sufficient experience to

be of assistance in the consideration of the merits of the issues on appeal. During the appeal conference, the participants of the appeal conference will decide whether a new ground of appeal is appropriate. On the examiner's answer, the word “conferees” should be included, followed by the typed or printed names of the other appeal conference participants. The appeal conference participants will place their initials next to their name to make clear that the appeal conference has been held. A Technology Center Director or designee must also initial/approve an examiner's answer containing a new ground of rejection.

*Comment 65:* One comment suggests that allowing the examiner to institute a new ground of rejection in the examiner's answer is unfair to the appellant and the examiner should be required to reopen prosecution.

*Answer:* If the examiner institutes a new ground of rejection in the examiner's answer, then the appellant has two months to either request that prosecution be reopened by filing a reply under § 1.111 or file a reply brief under § 41.41, which would act as a request that the appeal be maintained. Accordingly, although the examiner may in limited situations institute a new ground of rejection on appeal, the appellant has the right to request that prosecution be reopened. An appellant may not wish to have prosecution reopened if the new ground of rejection is similar to a prior rejection or if the evidence of record is sufficient to address the rejection. Moreover, reopening prosecution may prolong examination without any benefit to the appellant.

*Comment 66:* One comment suggests that the new arguments are necessary in the appeal brief because the conferees and supervisors are more experienced than the examiner and if the case proceeds to the Board, the audience is an APJ, who has quite different qualifications than either the conferee or the supervisor. Moreover, the comment suggests that the rule is unnecessary because nothing in the rule prevents the examiner from responding to new arguments raised in the appeal brief.

*Answer:* Former § 1.193(a)(2) (2003) prohibited an examiner's answer from including a new ground of rejection except under very limited circumstances. Accordingly, an examiner could not respond to a new argument raised in an appeal brief by adding a new ground of rejection in the examiner's answer. Because the former appeal rules only allowed the examiner to make a new ground of rejection by reopening prosecution, some examiners

have allowed cases to go forward to the Board without addressing the new argument. Section 41.39(a)(2) will improve the quality of examination and possibly reduce pendency by providing for the inclusion of a new ground of rejection in an examiner's answer.

*Comment 67:* One comment suggests that the Office should require the examiner making a new ground of rejection to acknowledge any mistakes the examiner may have made, explain the time and circumstances in which the new ground of rejection became known to the examiner, and explicitly point out to which arguments in the brief the new ground of rejection is responsive.

*Answer:* The suggestion will not be adopted. The making of a new ground of rejection in an examiner's answer is in itself an acknowledgment of an error made in the rejection under appeal. Requiring the examiner to explain the time and circumstances in which the new ground of rejection became known to the examiner and to explicitly point out to which argument in the brief the new ground of rejection is responsive would delay prosecution and be of little or no value in determining the appropriateness of the new ground of rejection. As set forth above, a Technology Center Director or designee must initial/approve an examiner's answer containing a new ground of rejection. The Technology Center Director or designee will be aware that allowing a new ground of rejection in an examiner's answer is not open-ended but is envisioned to be rare rather than a routine occurrence. In addition, the Office plans to issue instructions that will be incorporated into the MPEP as to what circumstances would be appropriate for entry of a new ground of rejection in an examiner's answer rather than reopening of prosecution.

*Comment 68:* One comment suggests that any new grounds of rejection be limited to new rejections made in response to an argument presented for the first time in an appeal brief.

*Answer:* The comment is not adopted. As set forth above, the Office plans to issue instructions that will be incorporated into the MPEP as to what circumstances would be appropriate for entry of a new ground of rejection in an examiner's answer rather than reopening of prosecution. An examiner will be permitted to make a new ground of rejection in an examiner's answer in the situation where an examiner obviously failed to include a dependent claim in a rejection.

For example, in the final rejection, claims 1, 13, and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by

(c) An appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

#### § 41.33 Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

(d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

#### § 41.35 Jurisdiction over appeal.

(a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

(b) If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish jurisdiction to the examiner or take

other appropriate action to permit completion of the file.

(c) Prior to the entry of a decision on the appeal by the Board, the Director may sua sponte order the proceeding remanded to the examiner.

#### § 41.37 Appeal brief.

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph

(c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after

appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

#### § 41.39 Examiner's answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of

affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

#### § 41.41 Reply brief.

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

#### § 41.43 Examiner's response to reply brief.

(a)(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

#### § 41.47 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or supplemental examiner's answer.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. A hearing will be held as stated in the notice, and oral argument will ordinarily be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered.